No. 11,965

IN THE

United States Court of Appeals

For the Ninth Circuit

M. O. JOHNSTON OIL FIELD SERVICE CORPORATION,
Appellant,

vs.

LANE-WELLS COMPANY, a corporation,
Appellee.

OPENING BRIEF ON BEHALF OF APPELLANT, M. O. JOHNSTON OIL FIELD SERVICE CORPORATION.

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Subject Index

Table of Authorities Cited

Cases

Statutes

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JURISDICTION.

The jurisdiction of this Court is invoked under Section 1292 of the *New* Judicial Code, as the suit is one arising under the patent laws of the United States, of which the District Court had jurisdiction under Section 24(7) of the Judicial Code as amended (28 U.S.C.A., Section 41(7)) and under Section 247D of the Judicial Code (Federal Declaratory Judgments Act, 28 U.S.C.A., Section 400).*

*Throughout this brief plaintiff below, M. O. Johnston Oil Field Service Corporation, will be referred to as "appellant Johnston" and defendant below, Lane-Wells Company, a corporation, will be referred to as "appellee Lane-Wells".

Reference to the Transcript of Record will be made by referring to said Record by the letter "R." followed by the number of the page referred to.

All emphasis ours unless otherwise noted.

Final judgment of the District Court was entered on February 26, 1948 (R. 77) and the notice of appeal, on behalf of appellant Johnston was filed May 11, 1948. (R. 81.)

BRIEF STATEMENT OF CASE.

This is an appeal (in the nature of a cross-appeal) by appellant Johnston, from a judgment of the United States District Court for the Southern District of California, adjudging United States Letters Patent No. 2,029,491 (R. 74), issued February 4, 1936, to be valid but not infringed by appellant, Johnston.

The patent in suit No. 2,029,491 is owned by the appellee Lane-Wells. The suit was instituted by the appellant, Johnston, under the patent statutes of the United States and under the Declaratory Judgments Act, Title 28, Section 400 U.S.C., after a controversy had arisen between appellant, Johnston, and appellee, Lane-Wells, concerning the validity of the patent and whether or not the acts of appellant, Johnston, constituted an infringement thereof.

The complaint (R. 2) prayed for a declaratory judgment that the acts of appellant Johnston did not infringe the patent in suit and that said patent and all the claims thereof were invalid.

The patent in suit No. 2,029,491 purports to broadly cover the combination of a well testing device (whether old or new in the art) regardless of its construction and mode of operation, and a perforating gun

(whether old or new in the art) regardless of its construction and mode of operation.

After trial, the District Court adjudged the patent in suit and the claims thereof to be valid, but adjudged that they were not infringed by the acts of appellant, Johnston. From this judgment appellee, Lane-Wells, appealed from that portion of the judgment of non-infringement, and appellant, Johnston (by this appeal), appealed from that portion of the judgment holding the patent in suit and the claims thereof valid.

The questions on this appeal by appellant, Johnston, are briefly:

Is the patent in suit valid in view of

(a) the evidentiary findings of fact made by the trial Court which we contend conclusively show lack of patentable invention in the production of the apparatus of the patent in suit;

(b) the evidentiary findings of fact made by the trial Court which we contend conclusively show that the patent is for a mere aggregation and not for a patentable combination;

(c) the evidentiary findings of fact made by the trial Court which we contend conclusively show that the apparatus of the patent in suit is inoperative and will not work practically in industry;

(d) the evidentiary findings of fact made by the trial Court which we contend conclusively show that the patent in suit is invalid for failure to comply with

R. S. § 4888, in that it fails to illustrate and describe an operative structure having utility?

Are not the claims of the patent in suit invalid in that they fail to comply with R. S. § 4888, because they are functional, ambiguous and indefinite?

The evidentiary findings of fact relied upon are not in conflict or dispute in this appeal in that they are all based upon substantial and uncontradicted evidence. It is only the ultimate findings and conclusions of "invention" and "validity" which are contended by appellant, Johnston, to be in error. It is our contention that in the state of the evidentiary facts specifically found by the District Court that the District Court erred in making its ultimate findings and conclusions that the patent involved invention and was valid. Thus, this case does not fall within the rule of the *Brodie* case (*Ralph N. Brodie Co. v. The Hydraulic Press Mfg. Co.,* 151 Fed. (2d) 91, but within the rule of *Kuhn v. Princess* (3 Cir.) 119 Fed. (2d) 704, which is as follows:

> "The appellee reminds us that we are not at liberty to disturb findings of fact made by the trial court unless they are unsupported by evidence or are otherwise clearly erroneous. Rule 52(a), 28 U.S.C.A. following section 723c.
>
> * * * * * * *
>
> The rule does not operate, however, to entrench with like finality the inferences or conclusions drawn by the trial court from its fact findings. And so, while accepting the facts competently found by the trial court as correct, an appellate court remains free to draw the ultimate infer-

ences and conclusions which, in its opinion, the findings reasonably induce. * * * Where the evidentiary facts are not in conflict or dispute, the conclusions to be drawn therefrom are for the appellate court upon review of the trial court's action. Cf. United States v. South Georgia Railway Co., 5 Cir., 107 F. 2d 3, and United States v. Mitchell, 8 Cir., 104 F. 2d 343, 346. An incorrect conclusion by a trial court qualifies as a 'clearly erroneous' finding, for the correction whereof on appeal Rule 52(a) specifically provides."

This Court approved the rule of that case in the case of *Home Indemnity Co. of New York v. Standard Acc. Ins. Co. of Detroit,* 167 Fed. (2d) 919. See also *Murray v. Novlesville Milling Co.,* 131 Fed. (2d) 470.

SPECIFICATION OF ERRORS.

1. The Court erred in finding and concluding that the Lane patent in suit No. 2,029,491 discloses a patentable invention, in that such finding and conclusion is contrary to the evidence and the evidentiary findings of fact.

2. The District Court erred in finding and concluding that claims 7 to 9, inclusive, and 11 to 14, inclusive, of the patent in suit complied with R. S. § 4888 and are valid in that such finding and conclusion is contrary to the evidence and the evidentiary findings of fact.

3. The District Court erred in finding and concluding that the Lane patent in suit is valid as to claims 7 to 9, inclusive, and 11 to 14, inclusive, in that such finding and conclusion is contrary to the evidence and the evidentiary findings of fact.

4. The District Court erred in not finding and concluding that the Lane patent in suit does not disclose a patentable invention, which finding and conclusion would be in accord with the evidence and the evidentiary findings of fact.

5. The District Court erred in not finding and concluding that claims 7 to 9, inclusive, and 11 to 14, inclusive, of the Lane patent do not comply with R. S. § 4888 and are invalid in that they are functional, vague and indefinite.

6. The District Court erred in not finding and concluding that the Lane patent is invalid as to claims 7 to 9, inclusive, and 11 to 14, inclusive, which finding and conclusion would be in accord with the evidence and the evidentiary findings of fact.

7. The District Court erred in not finding and concluding that the Lane patent is totally invalid, which finding and conclusion would be in accord with the evidence and the evidentiary findings of fact.

8. The District Court erred in not finding and concluding that the Lane patent in suit purports to cover a mere aggregation and not a patentable combination and is therefore invalid, which finding and conclusion would be in accord with the evidence and the evidentiary findings of fact.

9. The District Court erred in not finding and concluding that it required no more than mechanical skill to produce the apparatus of the patent in suit, and that said patent is therefore totally invalid, which finding and conclusion would be in accord with the evidence and the evidentiary findings of fact.

10. The District Court erred in not finding and concluding that the patent in suit purports to cover a mere use of an old tool or tools and therefore does not embody a patentable invention and is invalid, which finding and conclusion would be in accord with the evidence and the evidentiary findings of fact.

11. The District Court erred in not finding and concluding that the patent in suit does not describe and illustrate an apparatus which will work practically in industry and therefore it does not describe and illustrate the claimed invention as required by R. S. § 4888, and is therefore invalid, which finding and conclusion would be in accord with the evidence and the evidentiary findings of fact.

12. The District Court erred in not finding and concluding that all of the claims of the patent in suit are so functional, ambiguous and indefinite that they fail to comply with R. S. § 4888, and are therefore invalid, which finding and conclusion would be in accord with the evidence.

13. The District Court erred in not finding and concluding that the apparatus disclosed in the patent in suit will not work practically in industry when constructed and operated in accordance with the speci-

fications and drawings of the patent, and therefore the patent is totally invalid, which finding and conclusion would be in accord with the evidence and the evidentiary findings of fact.

SUMMARY OF THE ARGUMENT.

1. The District Court found (Finding 18, R. 56) that the circumstance which gave rise to the alleged invention of the apparatus of the patent in suit was that after the inventor had demonstrated that electrical control of perforator guns at the top of a well for firing such a gun perforator was safe, appellee, Lane-Wells, desired to cover by means of patents every possible application that the perforating gun might have and every means by which it might be operated, and we contend that in that state of fact the patent is invalid because it is for a "use" of a perforator gun and tester and the patent is therefore invalid.

2. That from the evidentiary findings of fact (Findings 18, 19, 22, 34, 35 and 36, R. 56, 57 and 60) made by the District Court and the evidence, it is clear that the patent in suit purports to patent a bare abstract "idea", and that the patent is invalid because of conception of a bare abstract "idea" and not an invention which can be patented. That the invention, if any, must be found in an apparatus to carry out the bare abstract "idea".

3. That from the evidentiary findings of fact (Findings 50 and 58, R. 63 and 64) made by the Dis-

trict Court and from the evidence, it is clear that one skilled in the art could, by merely exercising ordinary mechanical skill, produce an apparatus carrying out the bare abstract "idea" constituting the alleged invention into effect, and that therefore no patentable invention is disclosed in the patent in suit and it is invalid.

4. That the District Court found as fact (Findings 67, 68 and 69, R. 66 and 67) that in the accused apparatus the gun perforator separately performs its same old function in its same old manner, and the formation tester separately performs its same old function in its same old manner, and that the separate functioning of the gun does not modify or change the functioning of the formation tester, and that the separate functioning of the formation tester does not change or modify the functioning of the gun, and that they do not contribute to any joint function. From this it is evident that the result or end produced by the alleged "combination of the patent" is merely the sum of two separate and old results. Therefore, the patent and its claims which purport to include the accused apparatus is for an unpatentable aggregation and is totally invalid.

5. That from the evidentiary findings of fact (Findings 49, 50 and 59, R. 63 and 64) and the evidence, it is manifestly clear that only mechanical skill is required to connect an old perforator gun to an old formation tester, and therefore the patent which purports to cover such an aggregation is void for want of invention.

6. That from the evidentiary findings of fact (Findings 34 and 35, R. 59) made by the District Court and the evidence, it is manifestly clear that the apparatus shown in the Lane patent in suit will not work practically in industry when constructed and operated in accordance with the specifications and drawings of the patent, and that therefore the patent is totally and completely invalid.

7. That from the findings of fact (Findings 49, 68, 69 and 70, R. 63 and 67) of the District Court and the evidence, it is manifestly clear that the apparatus disclosed in the Lane patent in suit does not produce a new result or an improved result, nor does it produce and old result in a more economical and facile manner, and therefore its production did not rise to the dignity of patentable invention and the patent is therefore invalid.

8. That it is clear from the evidence (R. 356-357) and from the patent in suit itself (R. 480-483) that the claims of the patent in suit are so broad and ambiguous as to bar anyone from using (a) a gun perforator and a packer connected together (claims 7 and 12 of Lane patent), (b) a gun perforator and a formation tester (having the usual packer) connected together (Lane claims 8, 9, 11, 12, 13 and 14) regardless of the construction and mode of operation of said devices, and that such claims are therefore totally invalid as being functional, ambiguous, indefinite and failing to comply with R. S. § 4888.

A BRIEF HISTORICAL OUTLINE OF THE ART AND THE PATENT IN SUIT.

Prior to the patent in suit well testers were provided which were lowered into a well and were operative to take a sample of the fluid in the well.[1] Also, at that time gun perforators were provided which were capable of being lowered into a well bore to shoot holes in the casing to let in native fluid from the formation so it could be sampled.[2] It was and still is the practice of first lowering a gun perforator into the well and perforating the casing, and thereafter lowering the well tester into the well and taking a sample of the fluid in the well.[3 & 4]

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[1]Finding of Fact 14 and R. 101-104.

[2]Finding of Fact 16 and R. 169.

[3]Testimony of witness Johnston, R. 117.

[4]Prior art patents disclosing packers for dividing a well bore into an upper and lower zone are shown in the exhibits and discussed by the witness O'Neill in the record as follows:

Ex. 17A (R. 521), R. 275-277; Ex. 17B (R. 521), R. 277-278; Ex. 17D (R. 533), R. 285-286; Ex. 17E (R. 539), R. 286-287; Ex. 17F (R. 543), R. 287; Ex. 17G (R. 548), R. 291-292; Ex. 17H (R. 553), R. 289-290; Ex. 17I (R. 559), R. 290; Ex. 17J (R. 565), R. 291-292; Ex. 17K (R. 570), R. 293-294; Ex. 17L (R. 574), R. 294-295; Ex. 17N (R. 586), R. 298; Ex. 17O (R. 594), R. 299-301; Ex. 17P (R. 600), R. 301; Ex. 17Q (R. 607), R. 303; Ex. 17R (R. 613), R. 309; Ex. 17S (R. 617), R. 304-306; Ex. 17U (R. 632), R. 306-307; Ex. 17V (R. 641), R. 307.

Prior art patents disclosing well testers and discussed by the witness O'Neill are in the record as follows:

Ex. 17B (R. 521), R. 278-280; Ex. 17C (R. 529), R. 283-285; Ex. 17E (R. 539), R. 286-287; Ex. 17F (R. 534), R. 287; Ex. 17G (R. 548), R. 291-292; Ex. 17H (R. 553), R. 289-290; Ex. 17I (R. 559), R. 290; Ex. 17J (R. 565), R. 291-292; Ex. 17L (R. 574), R. 294-295; Ex. 17N (R. 586), R. 298; Ex. 17O (R. 594), R. 299-301; Ex. 17P (R. 600), R. 301; Ex. 17Q (R. 607), R. 301-303; Ex. 17S (R. 617), R. 304-306; Ex. 17U (R. 632), R. 306-307; Ex. 17V (R. 641), R. 307, and Ex. 17W (R. 646), R. 307-308.

Prior art patents disclosing casing perforating guns are shown in the exhibits and discussed by the witness O'Neill in the record as follows:

Ex. 17G (R. 548), R. 288-289; Ex. 17M (R. 581), R. 295-298; Ex. 17T (R. 624), R. 309.

At the time of the alleged "invention" of the patent in suit, the commercial use of both of these devices was relatively new, and the evidence will show that the appellee, Lane-Wells Company, had obtained control of the basic patent* in the gun perforating art and were commencing to commercialize such gun. (R. 274, 359 and 670.) The evidence and the findings of fact of the District Court will show that at that time the appellee Lane-Wells seeing the commercial possibilities of the gun, adopted a policy of attempting to patent the use of such gun and every application by which it could be used, to completely monopolize the same. This led to the birth of the alleged "invention" in suit, which in effect was the concept of the abstract idea of connecting a tester and a perforator gun together so that they could both be lowered into the well at the same time and successively operated, and then removed together. This, it was believed, would save some of the time normally used in operating the two devices. (R. 116.) Although the conception of this idea of this patent was in the year 1932, no combined perforator and tester appeared until appellant Johnston produced the accused apparatus in 1943. This despite the fact that the patent owner, appellee Lane-Wells had been during that time continuously in the business of gun perforating well casings on a large scale. (R. 374-375.) As a matter of fact, no device con-

*Mims' patent Ex. 17G, R. 548 claim No. of which is as follows:
2. A method of perforating a well casing in place in a well hole, which comprises lowering an explosive charge down the well casing, exploding the charge, and directing the force of the charge in the direction of the well casing and thereby perforating the same.

structed and operating as shown and described in the patent in suit has, according to the evidence and the findings of fact, ever been produced. (R. 57, 379.)

Appellant Johnston, after the expiration of appellee Lane-Wells' Mims patent (which appeared to control the idea of perforating casing by shooting holes in it),* produced the accused device by screwing together its well tester, which it and its predecessors had used continuously since prior to the patent in suit (R. 101-105), with a perforating gun which had been invented by one Collins. (R. 113-114.) Appellant Johnston separately operated these tools and still separately operates them (R. 117), but likewise combines them by screwing them together to make up the accused apparatus.

The Court found as fact (Finding 55, R. 64) that the Johnston Tester is made in strict accordance with the Johnston patent Exhibit No. 17U (R. 632), and that the Johnston Perforator Gun, which is the other part of the accused apparatus, is made in accordance with the Collins patents Exhibits Nos. 11A, 11B and 11C. (R. 493, 505 and 514.)

The Court also found as fact that the construction and mode of operation of the accused apparatus entirely differs from the construction and mode of operation of the apparatus of the patent in suit (Finding 78, R 69)† so that the only manner in which appellee can contend that the accused apparatus violates the patent in suit is to contend that the inven-

*See footnote page 12.

†Such separate operation of the tools is not contended to be an infringement.

tion involved was the conception of the bare abstract "idea" of connecting together any type of well tester or sampler, whether old or new in the art, and any type of well perforating gun, whether old or new in the art.

A typical claim of the patent in suit is as follows:

> "13. A gun type formation tester comprising: a gun means adapted to be lowered into a well bore and fire a projectile into the adjacent formation to form a fluid channel from the formation into the well bore; and means for entrapping for withdrawal fluid entering the well bore from said channel and having an intake port connectible with said channel, said gun means and entrapping means forming a tool entity adapted to be lowered as a unit into a well bore." (R. 483.)

THE ALLEGED "INVENTION" OF THE PATENT IN SUIT WAS ADMITTEDLY CONCEIVED SOLELY FOR THE PURPOSE OF MONOPOLIZING BY WAY OF A PATENT THE "USE" OF A GUN PERFORATOR.*

The District Court found as fact (R. 56):

> "17. At the time of the invention disclosed in Lane patent No. 2,029,491, defendant had control of the dominating patent covering gun perforating devices for well casing, namely Mims patent No. 1,582,184, Exhibit 17-G.
>
> 18. The circumstance which gave rise to the alleged invention of the combined gun type formation tester shown in the Lane patent in suit was that after the inventor had demonstrated to oilmen that electrical control at the top of the well bore for firing the gun perforator was safe and feasible, *defendant desired to cover by means*

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*Addressed to Specification of Errors 4 and 10.

of patents every possible application that the perforating gun might have and every means by which it might be operated."

The patentee Lane freely admitted in his testimony that the so-called "invention" was not made to solve any existing problem or to advance any science, but admittedly to aid him and his associates in creating a monoply by way of patents on "every possible application that the gun might have, every application that it might have and every means by which it might be operated." The testimony is as follows (R. 371):

"Q. Do you recall any circumstances that gave rise to your inventing this combined gun type formation tester that is shown in this patent which I have shown to you?

A. At the time that the gun itself was being developed, and after I had demonstrated to a bunch of oil men that electrical control at the top of the hole was safe and feasible, it was the thought down at Lane-Wells that we ought to tie up—you know what I mean by that, in patent terms—every possible application that the gun might have, every application that it might have and every means by which it might be operated.

Q. In other words, you mean by 'tie up,' to make a monopoly by means of patents?

A. Well, I don't like the word 'monopoly,' but, for the want of a better word, yes.

Q. In other words, to try to cover it by patent?

A. Yes, to protect ourselves as completely as possible.

Q. And so that gave rise to this invention that is disclosed in the Lane patent that you have been referring to?

A. That is right."

Such patenting of the "use" of a perforator gun (as distinguished from a gun of a new construction and mode of operation) is repugnant not only to the constitutional provision pertaining to patents but is also repugnant to the long line of authorities which provide that the use of a device, regardless of whether such use is new or old, is unpatentable.

> "It has long been settled that a mere use or function is not the subject of a patent, * * * Roberts v. Ryer, 91 U.S. 150, 157; Goshen Sweeper Co. v. Bissell Carpet Sweeper Co., 37 U.S. App. 555, 19 C.C.A. 13, and 72 Fed. 67, and cases there cited. It would seem to follow as a corollary to these two propositions that, where it requires substantially no change in the old device to adapt it to the new use, such adaptation can not be the subject of a patent, no matter how remote and unthought of the new use may be, * * *."
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> *F. R. Stearns Co. v. Russell,* 85 Fed. 218, 226 (C.C.A. 6th, 1898).

> "It is settled by many decisions of this Court, which it is unnecessary to quote from or refer to in detail, that the application of an old process or machine to a similar or analogous subject, with no change in the manner of application, and no result substantially distinct in its nature, will not sustain a patent, even if the new form of result has not before been contemplated. Hotchkiss v. Greenwood, 11 How. 248; Phillips v. Page, 24 How. 164, 167; Jones v. Morehead, 1 Wall. 155, overruling S. C. nom. Livingston v. Jones, 1 Fisher Pat. Cas. 521; Hicks v. Gelsey, 18 Wall. 670; Smith v. Nichols, 21 Wall. 112; Brown v. Piper, 91 U.S. 37; Roberts v. Ryer, 91 U.S. 150;

Keystone Bridge Company v. Phoenix Iron Company, 95 U.S. 274, 276; Planing Machine Company v. Keith, 101 U.S. 479, 491; Pearce v. Mulford, 102 U.S. 112; Heald v. Rice, 104 U.S. 737, 754-756; Atlantic Works v. Brady, 107 U.S. 192."

Pennsylvania R. R. v. Locomotive Co., 110 U.S. 490, 493, 494 (1884), 28 L.E. 222, 4 S.C. 220; 1884 C.D. 168, 270 O.G. 207.

THE "CONCEPTION" OF AN ABSTRACT "IDEA" IS UNPATENTABLE. THE INVENTION IF ANY MUST BE FOUND IN THE APPARATUS FOR CARRYING THE ABSTRACT IDEA INTO EFFECT. IF THOSE SKILLED IN THE ART CAN PRODUCE THE APPARATUS AFTER DISCLOSURE OF THE BARE "IDEA", NO PATENTABLE INVENTION HAS BEEN MADE.*

The contention of appellee, Lane-Wells, and one of the real issues here is whether or not the conception of the bare abstract "idea" of merely connecting two old separate tools (a perforator gun and a tester or sample receiver), together rises to the dignity of patentable invention and entitles the patent holder to a monopoly on simply connecting together any type of perforator gun and any type of well tester whether new or old and regardless of their construction or mode of operation.

To sustain the validity of the Lane patent in suit, it seems clear that this Court must decide that the conception of such an abstract "idea" entirely dissociated from any specific apparatus is patentable. This becomes manifest when the contended scope of

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*Addressed to Specification of Errors 1-4-7 and 10.

the Lane patent in suit is measured by the yardstick of the appellant's acts contended to violate that patent, and is further emphasized by the character of the claims of the patent in suit, of which claim 13 is typical and reads as follows:

> 13. A gun type formation tester comprising: a gun means adapted to be lowered into a well bore and fire a projectile into the adjacent formation to form a fluid channel from the formation into the well bore; and means for entrapping for withdrawal fluid entering the well bore from said channel and having an intake port connectible with said channel, said gun means and entrapping means forming a tool entity adapted to be lowered as a unit into a well bore. (R. 483.)

Note that this patent claim includes only two elements (defined only by their function) forming a tool entity (connected together) (a) gun means of any kind or character to perforate a well casing, (b) sampling and trapping means of any kind and character. Clearly, therefore, the claimed "invention" is the conception of the bare abstract "idea" of connecting a perforator gun of any type or class to a formation tester of any type or class.

We contend that conception of such a bare abstract "idea" is not patentable under the authorities. Particularly is this true when, as here, as the Court found as fact:

(a) the two old elements which are so connected together separately perform their same old functions in the same old way as they did when used separately. The Court's findings (R. 66-67) are:

"63. The Johnston Formation Tester, which forms a part of the accused apparatus, is capable of, has been, and is now used separately from any other apparatus to test the formation penetrated by well bores by sampling the same.

64. The Johnston Perforating Gun, which is used as a part of the accused apparatus, is also capable of and is used separately from a testing tool or formation tester to perforate well casings in place in a well bore.

65. No structural modification was necessary, either in the Johnston Formation Tester or the Johnston Perforator Gun, in order to connect them together to form the accused apparatus.

66. When the Johnston Formation Tester and the Johnston Perforator Gun are connected together and lowered in a well bore for operation, they are each separately operated to perform exactly the same function in the same manner that they perform when run into a well bore separately.

* * * * * * *

68. When a perforating gun is connected to the lower end of a formation tester or sample receiver to be run into a well bore or well casing simultaneously, the operation of the gun does not change or modify the operation of the formation tester or sample receiver, and the operation of the formation tester or sample receiver does not change or modify the operation of the perforating gun.

69. When a perforating gun is connected to the lower end of a formation tester or sample receiver to be run into a well bore or well cas-

ing simultaneously, each device separately operates in its old accustomed manner, and there is no change in the operation of either, save and except the length of the time interval between the operation of the two devices."

(b) no physical change in construction or change in mode of operation of the two devices is necessary to effect the connecting of the two tools together (as the Court also found as fact). (R. 66):

"65. No structural modification was necessary, either in the Johnston Formation Tester or the Johnston Perforator Gun, in order to connect them together to form the accused apparatus.

* * * * * * *

67. In the use of the accused apparatus, the Johnston Perforating Gun is screwed to the bottom of the Johnston Formation Tester and the two are lowered into the well bore simultaneously, and upon reaching the point of testing, the Johnston Perforator Gun is operated and fired in precisely the same manner that it is operated and fired when it is run into a well casing for perforating without a Johnston Formation Tester; and after firing the accused apparatus is elevated in the well bore and then the packer of the Johnston Formation Tester is set and the Johnston Formation Tester in all respects is operated precisely as it is operated when it is run into a well bore for making a test without the Johnston Perforator Gun connected therewith."*

*Findings of Fact 63 to 66 and 69 are established by the uncontradicted testimony of the witness Johnston at R. 118-120 and Findings of Fact 67 and 68 are established by the uncontradicted testimony of the witness O'Neill at R. 267-269.

That the conception of such an abstract idea is unpatentable is clear from the following authorities:

This Court so ruled (1933) in *Killefer Mfg. Co. v. Dinuba Associates, Ltd.*, 67 Fed. (2d) 362, at 366:

> "Claim 1 of the Petzoldt patent, broadly construed as applying to all power lifting farm machinery, is merely an idea. The idea thus sought to be monopolized is that of incorporating into any earth-working implements a lifting device wherein the lifting power will be applied through a pawl temporarily hooked over a pin in a wheel attached to the traction wheel of the implement (which pin corresponds mechanically to the tooth of a ratchet wheel) in such a manner that the following pin (corresponding to another tooth of a ratchet wheel) will release the pawl. * * * *The idea dissociated from a definite design and description of a machine is not patentable.*"

This Court recently reaffirmed this doctrine (1945) in *R. G. Le Tourneau, Inc. v. Gar Wood Industries, Inc.*, 151 Fed. (2d) 432, at 435:

> "Appellant repeatedly refers to its five basic concepts and insists that the conception of an abstract idea is an act of invention where the abstract idea involves the combination of old instrumentalities for a new result, where the conception of the idea is not within the scope of the ordinary workman skilled in the art, and where the idea has been incorporated into a useful machine. Appellant's theory is not entirely accurate, for when as here a result is not different in nature from results achieved by similar means in the past, invention must be embodied in the means for carrying the abstract

idea into effect, not merely in the conception of the idea. Knapp v. Morse, 1893, 150 U. S. 221, 228, 14 S.Ct. 81, 37 L. Ed. 1059; Wollensak v. Sargent, 1894, 151 U. S. 221, 227, 14 S.Ct. 291, 38 L. Ed. 137; Cuno Engineering Corporation v. Automatic Devices Corporation, 1941, 314 U. S. 84, 90-92, 62 S.Ct. 37, 86 L. Ed. 58; Page Steel & Wire Co. v. Smith Bros. Hardware Co., 6 Cir., 1933, 64 F. 2d 512, 514; Cleveland Punch & Shear Works Co. v. E. W. Bliss Co., 6 Cir., 1944, 145 F. 2d 991, 994."

As early as 1893 our Supreme Court so ruled in *Knapp v. Morse,* 150 U. S. 221, 14 S. Ct. 81, at 83:

"The use and purpose sought to be accomplished by the Hall patent was the radial expansion of the dress form, *but it is well settled by the authorities that the end or purpose sought to be accomplished by the device is not the subject of a patent. The invention covered thereby must consist of new and useful means of obtaining that end. In other words, the subject of a patent is the device or mechanical means by which the desired result is to be secured.* Carver v. Hyde, 16 Pet. 519; Le Roy v. Tatham, 14 How. 156; Corning v. Burden, 15 How. 252; Burr v. Duryee, 1 Wall. 531; Fuller v. Yentzer, 94 U. S. 299."

No invention is involved if one skilled in the art can readily produce the apparatus by mere mechanical skill once the "idea" is disclosed.

In *Wirebounds Patents Co. v. H. R. Gibbons Box Co.* (C.C.A.), 25 F. (2d) 363, 365, the Court said:

"It cannot be considered invention to describe and claim a process, or to produce a machine, or formulate a method which any successful mechanic would produce when required to effectuate a given result."

See

Lyman Mfg. Co. v. Bassick Mfg. Co. (C.C.A.), 18 F. (2d) 29, 34;

Galvin Electric Mfg. Co. v. Emerson Electric Mfg. Co. (C.C.A.), 19 F. (2d) 885.

The Court of Appeals for the Eighth Circuit quoted the *Wirebounds* case as above with approval in *Tropic-Aire v. Sears, Roebuck & Co.,* 44 Fed. (2d) 580, at 591.

The Supreme Court (1941) in *Cuno Engineering Corp. v. Automatic Devices Corp.,* 314 U. S. 84, 62 S. Ct. 37, clearly so ruled:

"To incorporate such a thermostatic control in a so-called 'wireless' or 'cordless' lighter was not to make an 'invention' or 'discovery' within the meaning of the patent laws. * * * *More must be done than to utilize the skill of the art in bringing old tools into new combinations.* (Citing cases.)

* * * * * * *

We may concede that the functions performed by Mead's combination were new and useful. But that does not necessarily make the device patentable. Under the statute, 35 U.S.C. § 31, 35 U.S.C.A. § 31, R. S. § 4886, the device must not only be 'new and useful', it must also be an 'invention' or 'discovery'. Thompson v. Boisselier, 114 U.S. 1, 11, 5 S. Ct. 1042, 1047, 29 L.Ed.

> 76. Since Hotchkiss v. Greenwood, 11 How. 248, 267, 13 L.Ed. 683, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art. (Citing cases.)"

On this same point the Circuit Court of Appeals for the Eighth Circuit in *Aro Equipment Corporation v. Herring-Wissler Co.* (1936), 84 Fed. (2d) 619, at 622, held:

> "This court, in the case of Tropic-Aire, Inc. v. Sears, Roebuck & Co., 44 F. (2d) 580, has reviewed many of the cases and laid down certain principles in regard to invention and patents which are binding in this circuit. Among them are the following:
>
> 'New thoughts, merely involving working out of mechanical skill to produce result, are not patentable.' "

We urge, therefore, that the patent in suit is devoid of patentable invention and is invalid.

IN THE ACCUSED APPARATUS THE GUN PERFORATOR SEPARATELY PERFORMS ITS SAME OLD FUNCTION IN ITS SAME OLD MANNER AND THE FORMATION TESTER SEPARATELY PERFORMS ITS SAME OLD FUNCTION IN ITS SAME OLD MANNER. THE SEPARATE FUNCTIONING OF THE GUN DOES NOT MODIFY OR CHANGE THE FUNCTIONING OF THE FORMATION TESTER AND THE SEPARATE FUNCTIONING OF THE FORMATION TESTER DOES NOT CHANGE OR MODIFY THE FUNCTIONING OF THE GUN, AND THEY DO NOT CONTRIBUTE TO ANY JOINT FUNCTION, THEREFORE, A PATENT OR CLAIM THEREOF WHICH INCLUDES THE ACCUSED APPARATUS IS FOR AN UNPATENTABLE AGGREGATION AND IS TOTALLY INVALID.*

The patent, as measured by the yardstick of the accused apparatus, which appellee, Lane-Wells, contends is the equivalent of the patent disclosure, is for an unpatentable aggregation and is therefore invalid. All that is done in the accused apparatus is to connect two old devices in juxtaposition and letting each device function in its old manner to accomplish only its old result unmodified by the other device to which it is connected. The Court so found as fact (R. 64, 67-68):

> "57. The accused apparatus is an instrumentality made up of a standard Johnston Formation Tester and a standard Johnston Perforator Gun screwed to the lower end of the Johnston Formation Tester.
>
> * * * * * * *
>
> 65. No structural modification was necessary, either in the Johnston Formation Tester or the Johnston Perforator Gun, in order to connect them together to form the accused apparatus.

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*Addressed to Specification of Errors 1-4-6-8 and 9.

66. When the Johnston Formation Tester and the Johnston Perforator Gun are connected together and lowered in a well bore for operation, they are each separately operated to perform exactly the same function in the same manner that they perform when run into a well bore separately.

67. In the use of the accused apparatus, the Johnston Perforating Gun is screwed to the bottom of the Johnston Formation Tester and the two are lowered into the well bore simultaneously, and upon reaching the point of testing, the Johnston Perforator Gun is operated and fired in precisely the same manner that it is operated and fired when it is run into a well casing for perforating without a Johnston Formation Tester; and after firing the accused apparatus is elevated in the well bore and then the packer of the Johnston Formation Tester is set and the Johnston Formation Tester in all respects is operated precisely as it is operated when it is run into a well bore for making a test without the Johnston Perforator Gun connected therewith.

68. When a perforating gun is connected to the lower end of a formation tester or sample receiver to be run into a well bore or well casing simultaneously, the operation of the gun does not change or modify the operation of the formation tester or sample receiver, and the operation of the formation tester or sample receiver does not change or modify the operation of the perforating gun.

69. When a perforating gun is connected to the lower end of a formation tester or sample

receiver to be run into a well bore or well casing simultaneously, each device separately operates in its old accustomed manner, and there is no change in the operation of either, save and except the length of the time interval between the operation of the two devices."

In that state of fact, under the authorities, the patent in suit purporting to cover such an aggregation is invalid as not being for a patentable invention, but for a mere aggregation.

Our Supreme Court has so uniformly ruled:

William Hailes and John G. Treadwell, Admrs. of Ellen Treadwell, Deceased v. Jasper Van Wormer, et al., 87 U. S. 241, 20 Wall. 353, 375 (1874).

"* * * No one by bringing together several old devices without producing a new and useful result, the joint product of the elements of the combination and something more than an aggregate of old results, can acquire a right to prevent others from using the same devices, either singly or in other combinations, * * *"

J. Reckendorfer v. Eberhard Faber, 92 U. S. 347, 2 Otto 347, 358 (1876).

"These patents relate to the manufacture of combined pencils and erasers.

* * * * * * *

It may be more convenient to have the two instruments on one rod than on two. *There may be a security against the absence of the tools of an artist or mechanic from the fact, that, the greater the number, the greater the danger of*

loss. It may be more convenient to turn over the different ends of the same stick, than to lay down one stick and take up another. *This, however, is not invention within the patent law,* as the authorities cited fully show. There is no relation between the instruments in the performance of their several functions, and no reciprocal action, no parts used in common. * * *"

Arthur Pickering, Charles H. Vickery, Henry D. Atwood, Exr. of Chas. H. Atwood, Deceased, and the Phoenix Manufacturing Company v. Michael McCullough, Jr., et al., Partners, as McCullough, Dalzell & Co., 104 U.S. 310, 14 Otto 310-319 (1881).

"* * * In a patentable combination of old elements, all the constituents must so enter into it, as that each qualifies every other; to draw an illustration from another branch of the law, they must be joint tenants of the domain of the invention, seized each of every part, per my et per tout, and not mere tenants in common, with separate interests and estates. * * *"

Stephenson v. Brooklyn Cross-Town R. Co., 114 U.S. 149, 5 S. Ct. 777 (1885).

"* * * We are of opinion that the alleged combination of these three elements, as described in this patent, is not patentable. There is, in fact, no combination, but a mere aggregation of separate devices, each of which performs the function for which, when used separately, it was adapted, and does not contribute to any new result, the product of their joint use. * * * There is, therefore, no patentable combination."

Brinkerhoff et al. v. Aloe, 146 U.S. 515, 13 S. Ct. 221 (1892).

" * * * If several old devices are so put together as to produce even a better machine or instrument than was formerly in use, but each of the old devices does what it had formerly done in the instrument or machine from which it was borrowed, and in the old way, *without uniting with other old devices to perform any joint function, it seems that the combination is not patentable.* Hailes v. Van Wormer, supra (20 Wall. 353); Reckendorfer v. Faber, 92 U.S. 357. * * * "

Richards v. Chase Elevator Co. et al., 158 U.S. 299, 15 S. Ct. 831 (1895).

" * * * So long as each element performs some old and well-known function, the result is not a patentable combination, but an aggregation of elements. * * * "

Grinnell Washing Mach. Co. v. E. E. Johnson Co., 247 U.S. 426, 38 S. Ct. 546 (1918).

"Confessedly all the elements of the Phillips patent are old. * * * These things, the simultaneous washing and wringing, with the operation of the control handle, for the purposes stated, embrace the advances alleged to have been accomplished upon the prior art. * * * The question is, does this bringing together of old elements accomplishing the purposes stated amount to that combination which is invention within the meaning of the patent law;

* * * * * * *

Applying the rule thus authoritatively settled by this Court, we think no invention is shown in

assembling these old elements for the purposes declared. No new function is 'evolved from this combination'; the new result, so far as one is achieved, is only that which arises from the well-know operation of each one of the elements."

Cuno Engineering Corporation v. Automatic Devices Corporation, No. 37, 314 U.S. 84, 62 S. Ct. Rep. 37 (1941), mandate amended 314 U.S. 587, 62 S. Ct. 476.

"We may concede that the functions performed by Mead's combination were new and useful. But that does not necessarily make the device patentable. * * *

Tested by that principle Mead's device was not patentable. We cannot conclude that his skill in making this contribution reached the level of inventive genius which the Constitution, Art. I, Sec. 8, authorizes Congress to reward. He merely incorporated the well-known thermostat into the old 'wireless' lighter to produce a more efficient, useful and convenient article. * * * "

This Court of Appeals has uniformly followed the rule above enunciated.

Ray et al. v. Bunting Iron Works, 4 Fed. (2d) 214 (1925).

" * * * The use of electric motors to propel machinery; the use of centrifugal atomizing cups to atomize fuel oil, and the use of centrifugal fans to create air currents, are all old in the art, and to assemble motor, fan, and cup on a single shaft is not invention. * * * "

Eagle et al. v. P. & C. Hand Forged Tool Co., 74 Fed. (2d) 918 (1935 (C.C.A. 9).

"It is not necessary that all of the elements of the claim be found in one prior patent. If they are all found in different prior patents and no new functional relationship arises from the combination, the claim cannot be sustained. Keene v. New Idea Spreader Co. (C.C.A.) 231 F. 701; see also Keszthelyi v. Doheny Stone Drill Co. (C.C.A.) 59 F. (2d) 3.

Dallas Machine & Locomotive Works Inc. v. Willamette-Hyster Co. et al., 112 Fed. (2d) 623 (1940) (C.C.A. 9).

"We believe, therefore, that the applicable rule is the one stated in Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U.S. 545, 58 S. Ct. 662, 82 L. Ed. 1008, that the 'mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention.' * * * "

Fernandez v. Phillips et al., 136 Fed. (2d) 404 (1943) (C.C.A. 9).

" * * * The combination claimed by Day is in effect the combination of such a fan with a standard refrigerator car. Old elements may be combined into patentable invention, but, 'so long as each element performs some old and well-known function, the result is not a patentable combination, but an aggregation of elements.' (Citing cases) * * *"

The Courts of the other circuits uniformly follow the same rule.

Clisby et al. v. Reese (C.C.A. 7), 88 Fed. 645 (1898).

" * * * But the claim of the plaintiff to invention consists in combining these three things, to-wit, a broom-corn thresher, an exhaust fan on top of the case to take away the dust, and an elevator at the side to scoop the grain from the bin where it is deposited, and carry it away to a convenient place. There is nothing to show wherein these three things operate jointly to produce anything which is the result of their united action. Each of these elements appear to operate separately to produce its own separate individual result, just as they might in connection with any other business where an exhaust fan was needed to draw away the air from a given space, and an elevator with endless belts and buckets to carry any given substance to another place or to a different level. * * * "

American Chocolate Machinery Co. v. Helmstetter (C.C.A.2), 142 Fed. 978 (1905).

"* * * The distinction between a combination and an aggregation lies in the presence or absence of mutuality of action. To constitute a combination it is essential that there should be some joint operation performed by its elements, producing a result due to their joint and cooperating action, while in an aggregation there is a mere adding together of separate contributions, each operating independently of the other. (Citing cases.)"

Moore et al. v. Saunders (C.C.A. 8), 247 Fed. 314 (1917).

"* * * No ingenuity was displayed in coupling an old feeding device with means for opening, moistening, and sealing, which was also old. To be sure the new assemblage accomplishes as an entirety more than either old element did in separate operation, and in a way the elements were, as was said below, 'successively cooperative'. But the cooperation was like that of the successive changes of horses in a coach journey from London to Bath. Those out of London, their task done, dropped their burden at Maidenhead; others picked it up there, and carried it to Newbury; and so on to destination. There was, of course, a 'successive cooperation'; but in the sense of the patent law a patentable combination of old elements mean more than that. * * *

There must be a coaction between them, and not a mere hitching up of separate contributions, each one of which continues independently to perform its customary function; otherwise, there is but a mechanical juxtaposition that is not patentable. In this import, plaintiff's feeding device does not coact with his means of opening, moistening, and sealing the envelopes. Each continues to do its old work in the old way. * * *"

Lundie Engineering Co. v. Railroad Supply Co. (C.C.A.7), 8 Fed. (2d) 995 (1925).

"* * * The elements are all old and well known in the art, and the only question is, Does the bringing together of these old elements in the manner and for the purposes stated amount to a

combination which involves invention, or does it show merely an aggregation of old elements performing their well-known functions? * * * There is no mutuality of action, no inter-action, no cooperation, between them. Each acts just as it did when used alone. The result comes, not from the coaction of the elements, but from collecting the three elements together. This is mere aggregation, and does not involve invention."

Sands Mfg. Co. v. Smith (C.C.A.6), 53 Fed. (2d) 459 (1931).

"* * * Although Smith thus evolved a unitary structure, he did no more than bring together two separate and distinct devices—(1) the ordinary pressure valve; and (2) the temperature valve or fusible plug of Ross.

* * * * * * *

There is no joint operation between the temperature plug and the pressure valve. They were not designed to co-act. * * * He may have produced a more attractive and salable device, but it was not invention."

Demo, Inc. et al. v. Doughnut Mach. Corporation, Joe-Lowe Corporation et al. v. Same (C.C.A.4), 62 Fed. (2d) 23 (1932).

"We come next to the contention that the machines of defendants infringe claims 7 and 58 of Bergner patent No. 1,492,541 because they employ a doughnut former in connection with the cooking machine. We understand that no contention is made that the use of the doughnut former alone would constitute an infringement

of the Bergner patent. The contention is that the use of the former in connection with the cooling machine, so geared as to deposit doughnuts at definite intervals in accordance with the capacity of the cooling machine, is protected by the patent. But this is mere aggregation. (Citing cases.) It did not constitute invention to equip a cooking machine with a previously known doughnut former. As to the synchronization of the two, this was a mere matter of mechanics, not beyond the powers of any skilled artisan. In so far, therefore, as the claims of Bergner patent No. 1,492,541 relate to the combination of the doughnut former with the cooking machine, they are void for lack of invention. * * *"

Doughnut Mach. Corporation v. Joe-Lowe Corporation et al. (C.C.A.4), 67 Fed. (2d) 135, 71 Fed. (2d) 424 (1933).

"All that the patentee has done here is to bring together the auger feed, which, as we have already shown, was old in the art, and the circular disc cutter cooperating with a sleeve through which the plastic material is extruded, which was also old, being disclosed in the patents to Megson 573,432, Hueg 560,719, and Williams 778,295. The synchronization of the two was a mere matter of mechanics not beyond the power of any skilled artisan. * * *"

Magnavox Co. Inc. v. Talking Sales Pictures, Inc. (C.C.A.7), 126 Fed. (2d) 669 (1942).

"* * * It is rather plain, we think, that the result is merely the total of the separate results produced by the various units prior to their as-

semblage by the patentee. No new or different result was achieved. The most that may be said in favor of the patentee is that he produced a result more efficiently and perhaps with less expense."

Also so holding are the following:

Atlantic Works v. Brady; Brady v. Atlantic Works, 107 U.S. 192, 2 S. Ct. 225 (1883);

Thatcher Heating Co. and Others v. Burtis and Another, 121 U.S. 286, 7 S. Ct. Rep. 1034 (1887);

Royer v. Roth et al., 10 S. Ct. 58, 132 U.S. 201 (1889);

Florsheim et al. v. Schilling, 137 U.S. 64, 11 S. Ct. 20 (1890);

Fond du Lac County v. May, 137 U.S. 395, 11 S. Ct. 98 (1890);

Busell Trimmer Co. et al. v. Stevens et al., 137 U.S. 423, 11 S. Ct. 150 (1890);

Union Edge Setter Co. v. Keith, 139 U.S. 530, 11 S. Ct. 621 (1891);

Office Specialty Mfg. Co. v. Fenton Metallic Mfg. Co., 174 U.S. 492, 19 S. Ct. 640 (1899);

Powers-Kennedy Contracting Corporation et al. v. Concrete Mixing & Conveying Co., v. R. C. Storrie & Co., 282 U. S. 175, 51 S. Ct. 95 (1930);

Paramount Publix Corporation v. American Tri-Ergon Corporation, 294 U. S. 464, 55 S. Ct. 449 (1935);

Toledo Pressed Steel Co. v. Standard Parts, Inc., Same v. Huebner Supply Co., Montgomery Ward & Co., Inc. v. Toledo Pressed Steel Co., 307 U. S. 350, 59 S. Ct. 897 (1939);

Mettler v. Peabody Engineering Corporation et al., 77 Fed. (2d) 56 (1935) (C.C.A. 9);

Nye & Nissen v. Kasser Egg Process Co., 96 Fed. (2d) 420 (1938) (C.C.A. 9);

Ashton Valve Co. v. Coale Muffler & Safety Valve Co. et al. (C.C.A. 4), 52 Fed. 314 (1892);

General Electric Co. v. Yost Electric Mfg. Co. et al. (C.C.A. 2), 139 Fed. 568 (1905);

Dodge Coal Storage Co. v. New York Cent. & H. R. R. Co. (C.C.A. 2), 150 Fed. 738 (1907);

Anton v. Grier Bros. Co. (C.C.A. 3), 185 Fed. 796 (1911);

Condit Electrical Mfg. Co. v. Westinghouse Elec. & Mfg. Co. (C.C.A. 1), 200 Fed. 144 (1912);

Gas Machinery Co. v. United Gas Improvement Co. (C.C.A. 6), 228 Fed. 684 (1915);

Turner v. Lauter Piano Co. et al. (C.C.A. 3), 248 Fed. 930 (1918);

Firestone Tire & Rubber Co. v. Seiberling (C.C.A. 6), 257 Fed. 74 (1918);

Universal Rim Co. v. Firestone Tire & Rubber Co. et al. (C.C.A. 6), 7 Fed. (2d) 24 (1925);

Angier et al. v. Nehring Electrical Works (C.C. A. 7), 45 Fed. (2d) 354 (1930);

Jones-McLaughlin, Inc. v. Amerada Petroleum Corporation (C.C.A. 10), 47 Fed. (2d) 828 (1931);

Patent & Licensing Corporation v. Weaver-Wall Co. (C.C.A. 6), 95 Fed. (2d) 182 (1938);

Butex Gas Co. et al. v. Southern Steel Co. (C.C. A. 5), 123 Fed. (2d) 954 (1941).

We urge, therefore, that the Lane patent is invalid on the ground that it purports to cover a mere aggregation and not patentable combination.

THE ONLY EVIDENCE IS THAT IT REQUIRED ONLY MECHANICAL SKILL TO CONNECT AN OLD PERFORATOR GUN TO AN OLD FORMATION TESTER TO EFFECT THE UNION AND THEREFORE NO PATENTABLE INVENTION WAS INVOLVED.*

As is clear from the testimony of M. O. Johnston (R. 119-120) and Frank O'Neill (R. 267-269), no appreciable modification had to be made in the old patented testers and perforator guns to combine them into a combined perforator and tester, and that the prior art devices could obviously be connected together by mere mechanical skill.†

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*Addressed to Specification of Errors 1 and 9.

†To illustrate that the assembly of two old prior art devices to meet the abstract "idea" alleged to be the "invention" of the patent in suit involved but simple mechanical skill, the Court is referred to the diagram on the following page, which except for the printed matter thereon is the same as Ex. 22, R. 655, and shows the formation tester of Simmons Patent No. 1,930,987 (Ex. 17-S, R. 617) combined with the well casing perforator gun of Mims Patent No. 1,582,184 (Ex. 17-G, R. 548), and the testimony of the witness O'Neill appearing at R. 310 to 317, and set forth in part

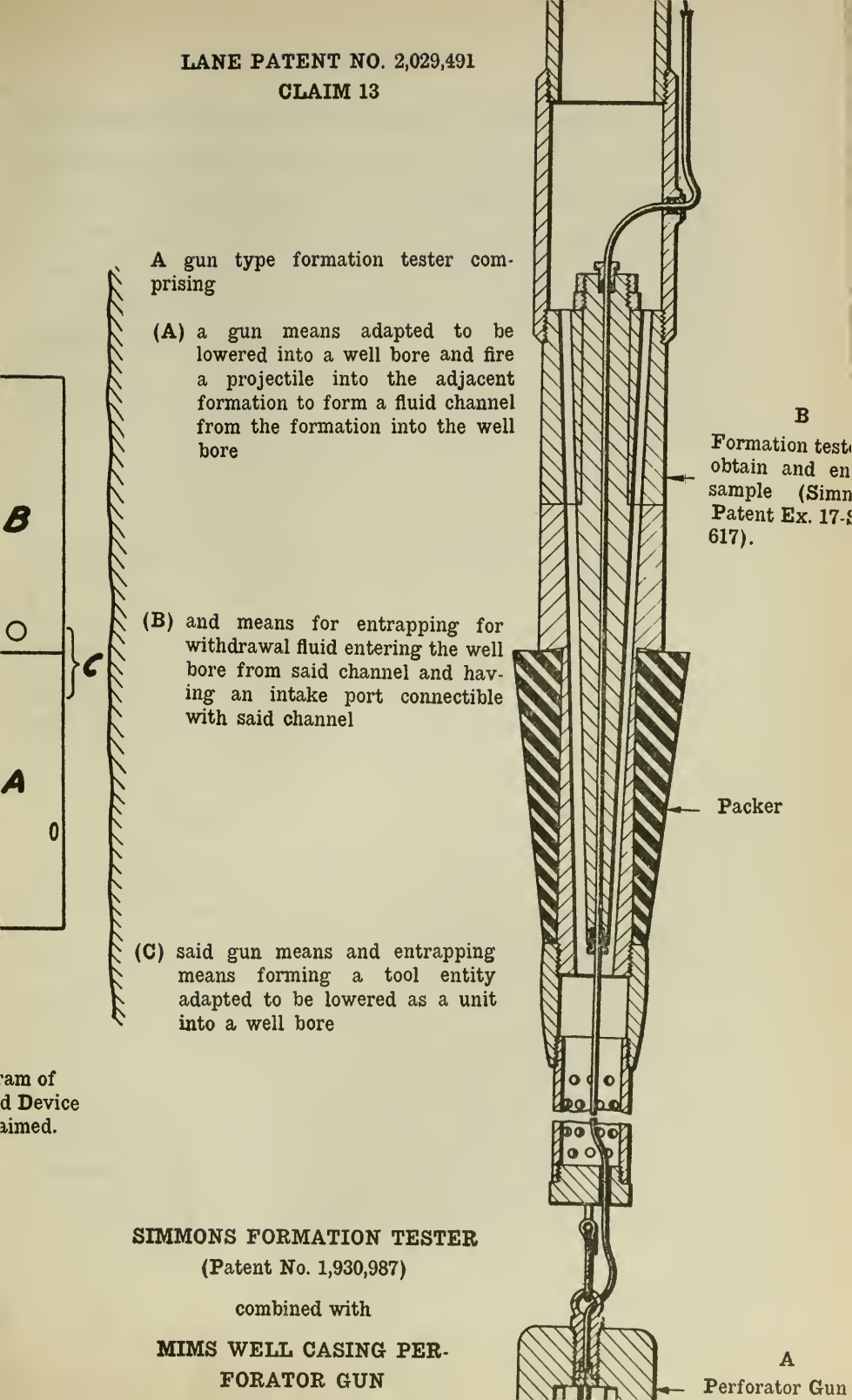
LANE PATENT NO. 2,029,491
CLAIM 13

A gun type formation tester comprising

(A) a gun means adapted to be lowered into a well bore and fire a projectile into the adjacent formation to form a fluid channel from the formation into the well bore

(B) and means for entrapping for withdrawal fluid entering the well bore from said channel and having an intake port connectible with said channel

(C) said gun means and entrapping means forming a tool entity adapted to be lowered as a unit into a well bore



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d Device
aimed.

SIMMONS FORMATION TESTER
(Patent No. 1,930,987)

combined with

MIMS WELL CASING PERFORATOR GUN

To combine the gun and tester in the accused apparatus, it was only necessary to screw them together. (R. 265.) No modification in construction or operation had to be made in either in order to combine them. Certainly, this is within the province of one skilled in the art and, therefore, the aggregation of these two elements into a single unit did not amount

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hereinbelow, describing how the Simmons tester and Mims gun can be very simply connected to produce a gun type formation tester such as claimed in Lane Patent No. 2,029,491 (Ex. 1, R. 479) :

"Q. (by Mr. Mellin). Now, Mr. O'Neill, will you refer to the Mims Patent, No. 1,582,184, Exhibit 17-G for identification and to the Simmons Patent, 17-S for identification, and tell us whether or not you can assemble them or connect them together so that they can be run into a well bore at the same time for operation?

* * * * * * *

A. Yes, sir.

Q. (by Mr. Mellin). Will you tell us, please, the manner in which you would connect the two together so that they may be simultaneously run into a well bore and so that each could perform their separate duty, one of perforating and the other of testing the well? Did you make a drawing showing the manner in which you could connect them?

A. Yes, sir.

Q. And is this the drawing which I show you?

A. Yes, sir.

* * * * * * *

The Court. The small drawing has been marked Plaintiff's Exhibit 22 for identification, and the large one will be marked Exhibit 23 for identification.

(The drawing referred to was marked as Plaintiff's Exhibit 23, for identification.)

The Court. That is a drawing of the witness' opinion as to how the Mims gun, depicted in 17-G, can be attached to the Simmons tester, Exhibit 17-S, is that correct?

The witness. Yes, sir, that is correct.

* * * * * * *

Q. (by Mr. Mellin). Just a moment, Mr. O'Neill. Does the drawing you made, except for the showing of a cable downwardly through the Simmons device and the changes necessary for that and the changes necessary to suspend the gun from it, conform to the drawings of the Simmons patent?

to patentable invention. On this point the Court found as follows (R. 64, 66):

"57. The accused apparatus is an instrumentality made up of a standard Johnston Formation Tester and a standard Johnston Perforator Gun screwed to the lower end of the Johnston Formation Tester.

58. It required only mechanical skill to perform the act of connecting the Johnston Formation Tester to the Johnston Perforating Gun to produce the accused apparatus.

* * * * * * *

65. No structural modification was necessary, either in the Johnston Formation Tester or the Johnston Perforator Gun, in order to connect them together to form the accused apparatus.

66. When the Johnston Formation Tester and the Johnston Perforator Gun are connected together and lowered in a well bore for operation,

---

A. Yes, sir.

Q. And does the drawing of the Mims gun at the bottom conform to the drawings of the Mims patent?

A. Yes, sir.

* * * * * * *

Q. Now, in your opinion, Mr. O'Neill, would a combination of the Simmons tester and the Mims gun be operative when assembled as you have shown, an operative structure?

A. Yes, it would be operative.

* * * * * * *

Q. Mr. O'Neill, with reference to the drawings, Plaintiff's Exhibits 22 and 23, for identification, showing the Mims gun combined with the Simmons tester, will you state whether or not there is any modification of the operation of the Simmons tester by such combination or connecting together?

A. None whatsoever, sir.

Q. And is the operation of the Mims gun modified or changed in any manner because of its connection with the Simmons tester?

A. Not at all, sir."

they are each separately operated to perform exactly the same function in the same manner that they perform when run into a well bore separately."*

In this state of fact the claims of the patent in suit, which purport to include the accused apparatus within their scope, are invalid as totally lacking invention.

On this precise point see:

Wirebounds Patents Co. v. H. R. Gibbons Box Co. (C.C.A. 7) (1928), 25 Fed. (2d) 363, 365, in which the Court held:

"It cannot be considered invention to describe and claim a process, or to produce a machine, or formulate a method which any successful mechanic would produce when required to effectuate a given result."

Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84, 62 S. Ct. 37 (1941):

"* * * More must be done than to utilize the skill of the art in bringing old tools into new combinations. (Citing cases.)

* * * * * * *

We may concede that the functions performed by Mead's combination were new and useful. But that does not necessarily make the device patentable. Under the statute, 35 U.S.C. § 31, 35 U.S.C.A. § 31, R. S. § 4886, the device must not only be 'new and useful', it must also be an 'invention' or 'discovery'. Thompson v. Boisselier,

*The above Findings are supported by the uncontradicted testimony of the witness O'Neill at R. 265-266 and the witness M. O. Johnston at R. 118-120.

114 U. S. 1, 11, 5 S.Ct. 1042, 1047, 29 L.Ed. 76. Since Hotchkiss v. Greenwood, 11 How. 248, 267, 13 L.Ed. 683, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art. (Citing cases.)"

The Circuit Court of Appeals for the Eighth Circuit in *Oro Equipment Corporation v. Herring-Wissler Co.* (1936), 84 Fed. (2d) 619, at 622, held:

" 'New thoughts, merely involving working out of mechanical skill to produce result, are not patentable.

Patent must be creation of inventive faculty and imagination, with something more than is obvious to persons skilled in the art.

Mere novelty and utility is not invention and cannot be substituted therefor.

Ingenuity does not constitute invention.' "

This Court of Appeals followed this rule in *Bailey v. Sears, Roebuck & Co.,* 115 Fed. (2d) 904:

"We conclude that the trial Court was correct in holding that a mechanic skilled in the art of radio condenser and cabinet construction, given the problem of measuring or determining the position of the rotors of the condenser by means of a clock faced dial, with two hands, one faster and one slower, already used in that art, would not require or exercise inventive genius in designing the patented device. Hence, such a mechanic cannot claim a patent monopoly and exclude other skilled mechanics from using the

same or equivalent devices. Hence, we hold that there was no invention in the patent under consideration."

THE ONLY EVIDENCE AND THE FINDING OF FACT BY THE DISTRICT COURT IS THAT THE DEVICE SHOWN IN THE LANE PATENT IN SUIT WILL NOT WORK PRACTICALLY IN INDUSTRY WHEN CONSTRUCTED AND OPERATED ACCORDING TO THE SPECIFICATIONS AND DRAWINGS OF THE PATENT.*

The Court found as a fact (and the testimony (R. 243-248) to that effect is uncontradicted) that the apparatus of the Lane patent constructed and operated as illustrated and described in the patent is inoperative to obtain and bring to the surface of the well a beneficial test sample, and, consequently, would be inoperative and impractical in industry under normal and usual circumstances.

> "34. Under normal and usual circumstances as described above in findings Nos. 25-30, the device of the Lane patent in suit, as disclosed therein, would be impractical in industry to recover and bring to the surface of the well a beneficial test sample, without the additional use of other auxiliary equipment or devices and operations not described or illustrated in the patent, and by a mode of operation not described or illustrated in the patent." (R. 34.)

The reason that the device of the patent in suit is inoperative and impractical as illustrated and described in the patent is that the ball valve 28 (on the

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*Addressed to Specification of Errors 1-11 and 13.

drawings of the patent and in the specification thereof) is intended to operate to prevent mud fluid from entering the tester when the packer of the tester is unseated. That ball valve 28 will not so function and consequently the amount of mud which will enter the patented device and its tubing, if it is attempted to elevate such sample to the surface, will be many times the amount of the sample taken into the device and manifestly render such sample useless for any practical purpose. In this regard, the Court found (R. 59):

> "32. In the Lane patented device the ball valve 28 will not function to prevent mud fluid from entering the tester when the packer is unseated in normal use of a tester in the oil fields, as described above in Findings Nos. 25-30.
>
> 33. Under normal conditions, as described above in findings Nos. 25-30, the amount of mud fluid which will enter the Lane device and its tubing after releasing the packer will be many times the amount of the sample taken into the device and its tubing from the formation.*
>
> 34. Under normal and usual circumstances as described above in Findings Nos. 25-30, the device of the Lane patent in suit, as disclosed therein, would be impractical in industry to recover and bring to the surface of the well a beneficial test sample, without the additional use of other auxiliary equipment or devices and operations not described or illustrated in the patent, and by a mode

*The above Findings are supported by the uncontradicted testimony of the witness Barton at R. 364-367 and the witness O'Neill at R. 326-327, 332, 336-348.

of operation not described or illustrated in the patent.

35. The Lane patent in suit fails to disclose a device which is of any practical benefit to the oil industry, unless additional auxiliary devices or equipment not described or illustrated in the patent are used in connection therewith, to remove the sample from the device and elevate the sample to the surface of the well."

From these findings of fact, it is manifestly clear, and the evidence is uncontested and uncontradicted, that the apparatus disclosed in the patent will not by itself, constructed and operated as shown in the patent, be capable of producing at the surface of the well a sample which would be of any use at all. In this regard, see the testimony of the unbiased witness Barton, who testified (R. 362) that he was a petroleum engineer with a bachelor of science degree, and was employed by the State of California as senior oil and gas engineer for the last nineteen (19) years.

His testimony on the point that if the mud or well fluid can enter the tester following the path of the sample, as set forth in Findings of Fact Nos. 32 and 33 above set out, that such a tool would be of no practical benefit in testing a well. His testimony follows (R. 364, 365, 366):

"Q. Speaking of a Johnston tester without the gun, Mr. Barton, and assuming that in a tool of that character no means is provided to exclude the well fluid from entering the tool following the same path that the sample entered in the tool, so that the fluid in the tool and in its tubing always

equalized with the mud fluid in the well, in your opinion would or would not such a tool be of any practical benefit in testing a well for water shutoff?

* * * * * * *

The Witness. My answer to that would have to be no.

Q. (by Mr. Mellin). And would you state your reasons for your answer, Mr. Barton?

A. Well, in testing a water shutoff on a string of casing that has been cemented in the well, it is necessary to obtain a sample of fluid which comes into the drill pipe or tubing during the time the valve is open, and which is below the point at which the packer is set. If the fluid behind the drill pipe or tubing were allowed to be equalized after the packer was released, it would be impossible to identify the character of the fluid which entered during the time the valve was open.

Q. Have you finished your answer, Mr. Barton?

A. Yes.

Q. Now, in making a water shutoff test by a tester of the type of the Johnston formation tester, assuming that the packer is tight and set and the tool is open to take a sample, and thereafter the packer is released and the mud fluid in the well under the hydrostatic head has free access to flow into the tool following the taking of the test sample, and the fluid in the tool equalized with the mud fluid in the well bore, in your opinion would or would not such a test be of any practical benefit in determining whether or not a water shutoff had or had not been effected?

A. No."

Under the above state of fact, the patent is totally invalid and void as will be shown by the authorities herein later quoted for two reasons:

(a) because the device as shown and described in the patent will not function practically and is not useful.

(b) because the patent fails to illustrate and describe an operative and useful device.

The fact that the device of the patent in suit may be made to work to a limited degree by the additional use of auxiliary devices or equipment (not described or illustrated in the patent) operated in connection therewith to remove the sample from the device and elevate it to the surface of the well, cannot remedy the fatal defect of inoperativeness and impracticability of the device as shown and described in the patent.

The fact that the device will not work practically in industry when constructed according to the patent specifications is fatal to the patent and the latter is invalid as not being useful, and the patent cannot now be sustained upon a showing that it can be made to work if additional auxiliary devices not shown or described in the patent are added to the apparatus.

In the widely accepted modern authority on the point, *Besser v. Merrilat Gulvert Core Co.,* 243 Fed. 611, 612 (C.C.A. 8) (1917), it was held:

> *"If, however, it will not work practically in industry when constructed according to the claims and specifications, it is not useful, and cannot be sustained upon a showing that it can be made to*

work by a small improvement. That is the objection to the suggestion of plaintiff here that if a wire be applied to his machine it can be made to work some. * * * Plaintiff had a new idea. It was valuable in industry. Unfortunately for him, however, an idea is not patentable. Only a machine is patentable, and when plaintiff undertook to embody his idea in a machine he did not give it an expression which would work in industry. His machine, therefore, was not patentable.

The defendant has met this difficulty by attaching a system of torsion springs to the plates, so as to produce and maintain the desired resiliency. This new element is fundamental to the structure, and defendant, by adding it, was the first to embody the invention in a workable and useful form."

If the apparatus of the patent will not accomplish the result without addition or subtraction to the apparatus disclosed, the patent is invalid.

The rule is clearly stated in *O'Reilly v. Morse* (Telegraph Case), 15 How. 62, 56 U.S. 62, 14 L. Ed. 601:

"The provisions of the Acts of Congress in relation to patents may be summed up in a few words.

Whoever discovers that a certain useful result will be produced, in any art, machine, manufacture or composition of matter, by the use of certain means, is entitled to a patent for it; *provided he specifies the means he uses in a manner so full and exact, that anyone skilled in the science to which it appertains, can, by using the means he*

specifies, without any addition to or subtraction from them, produce precisely the result he describes. And if this cannot be done by the means he describes, the patent is void."

Again our Supreme Court so ruled in *Mitchell v. Tilghman,* 86 U.S. 287, 19 Wall. 287, 22 L. Ed. 125:

"2. Grant all that, still it is insisted by the respondent that the result described in the specification and claim of the patent cannot be accomplished so as to be practically useful by the method and apparatus described in the specification.

Whoever discovers that a certain useful result will be produced in any art, machine, manufacture or composition of matter by the use of certain means is entitled to a patent for his invention, provided he specifies the means he uses * * *. *Such description must be correct, as it is settled law that the patent is void if the described result cannot be obtained by the described means.* * * *"

Again our Supreme Court so ruled in *Beidler v. United States,* 253 U.S. 447, 453 (1920), 40 S. Ct. 564:

"Ever since *Grant v. Raymond,* 6 Pet. 218, 247, *it has been consistently held that a correct and adequate description or disclosure of a claimed discovery (which, in the case of a machine, involves particularly the operation of it) is essential to the validity of a patent,* for the reason that such a disclosure is necessary in order to give the public the benefit of the invention after the patent shall expire. The source of the power to grant patents, and the consideration for granting

them, is the advantage which the public will derive from them, especially after the expiration of the patent monopoly, when the discoveries embodied in them shall become a part of the public stock of knowledge.

The application of these requirements of the law to our conclusion that *the only form of construction of the machine and the only method of operation of it which are disclosed in the patent would not produce a sufficiently uniform and rapid development of the film to render it useful,* must result in the approval of the judgment of the Court of Claims, *that the patent is invalid and void,* for the reason that it fails to disclose a practical and useful invention."

See also *Houston v. Brown Mfg. Co.,* 270 Fed. 445, at 448:

"Of course, if, as claimed, this purported invention added nothing to the knowledge of the cultivator art, and would not accomplish its purpose practically when applied in industry, or was so negligible in its nature as to be wholly immaterial in results, then it is necessarily invalid. Coupe v. Royer, 155 U.S. 565, 15 Sup. Ct. 199, 39 L.Ed. 263; Besser v. Merrilat, 243 Fed. 611, 612, 156 C.C.A. 309 (C.C.A. 8); Scott v. Fisher Knitting Mach. Co. (C.C.) 139 Fed. 137-146; Carter Mach. Co. v. Hanes et al. (C.C.) 70 Fed. 859."

The fact that the patented device must, in order to operate even to a limited extent, be further combined with addition of auxiliary devices cannot save the patent because such addition of new tools to the Lane patent apparatus and the giving such apparatus a new

mode of operation, in effect rewrites the patent and clearly renders the patent void as not satisfying the requirements of R.S. 4888, 35 U.S.C.A. § 33.

The Supreme Court in *Permutit Co. v. Graver Corporation,* 284 U.S. 52, 52 S.Ct. 53, said:

> "* * * For even if a patent for a 'free' bed might have been valid, that sued on is invalid for lack of the disclosure prescribed in 5 Rev. St. § 4888. (35 U.S.C.A. § 33.) There is no mention in the specification of either a 'free' or a 'locked' zeolite bed; or of the alleged discovery that a rising space above the zeolite bed is necessary for the successful operation of the softener; or of the need of a device to prevent the lighter grains of zeolite from passing out in back-washing. * * * As the patentee has thus failed to give in the specification 'a written description' * * * the patent is void."

In *Special Equipment Co. v. Ooms,* 153 Fed. (2d) 121, the United States Court of Appeals, District of Columbia, held:

> "One of the fully established requirements of the patent law is that the applicant must disclose what he claims and how it works. 'In case of a machine the description must disclose the best mode in which the inventor has contemplated the application of his discovery, R.S. §4888. (35 U.S.C.A. § 33.) Ever since Grant v. Raymond, 6 Pet. 218 (247), 8 L.Ed. 376, it has been consistently held that a correct and adequate description or disclosure of a claimed discovery (which, in the case of a machine, involves particularly the operation of it) is essential to the validity of a patent.' * * *"

FROM THE FINDINGS OF FACT OF THE DISTRICT COURT IT IS CLEAR THAT THE APPARATUS DISCLOSED IN THE LANE PATENT IN SUIT DOES NOT PRODUCE (a) A NEW RESULT, (b) AN IMPROVED RESULT, NOR DOES IT PRODUCE AN OLD RESULT IN A MORE ECONOMICAL AND FACILE MANNER AND THEREFORE ITS PRODUCTION DOES NOT RISE TO THE DIGNITY OF PATENTABLE INVENTION.*

The advantage of the accused apparatus in assembling a perforator gun and a tester on one string of drill pipe (but such advantage is absent in the patented apparatus) is that by simultaneously running the perforator gun and tester, the time required to perforate and to take a test sample is less than the time ordinarily required to perform these two operations when running the perforator gun and the tester separately.

This is the only advantage in combining the gun perforator and the tester when making water shut-off tests in a well, which operation accounts for ninety-eight per cent (98%) of the use of the accused tool. The Court so found as a fact (R. 67-68):

> "70. In making water shut-off tests in well casing, *there is no new or different result obtained by running the accused apparatus to perforate and make such a test over running a formation tester and a perforating gun separately* to make the test, *except a saving in time* required to perform the operations.
>
> 71. Approximately ninety-eight per cent (98%) of the use of the accused apparatus is de-

*Addressed to Specification of Errors 1-4-7-8 and 10.

voted to making water shut-off tests in well casing.'"*

However, *inasmuch as the apparatus of the patent in suit is incapable of elevating the sample to the surface* (and the Court so found as a fact—Finding No. 34 (R. 59)), bailers or some other tools must be employed in conjunction with the patented apparatus to run down into that tool while it is still in the well and remove the sample to the surface. Therefore, *in recovering a sample by the use of the apparatus illustrated and described in the patent in suit, there is no saving of time in recovering a sample.*

The Court so found as a fact (R. 60):

> "37. *If the Lane device were employed* to make a test and separate instrumentalities, such as bailers, were required to remove the test sample from the device so that the sample may be brought to the surface, *as much time would be required,* under the conditions described above in findings Nos. 25-30, *to make the test and recover such sample as would be required by the use of a separate perforating gun and formation tester.*"

Therefore, in the above ninety-eight per cent (98%) of the field of use of the patented apparatus no advantage is produced by the patented device (in that no time is saved) over the prior method of running the tester and gun perforator separately, because, as

*The above Findings are supported by the uncontradicted testimony of the witness Johnston at R. 116-120 and 426.

above explained, and as found by the Court in findings Nos. 70, 71, 34 and 37,* the only advantage in running a combined perforator and tester in making water shut-off tests is the saving in time. In that by using the apparatus of the patent in suit no saving of time is effected over such separate running of the tester and perforator gun, not only is no new result produced by the patented apparatus, but no improved result is produced by the patented apparatus, and no old result is produced by the patented apparatus in a more facile or economical manner.

As above set forth water shut-off tests account for ninety-eight per cent (98%) of the field of use of com-

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*"70. In making water shut-off tests in well casing, there is no new or different result obtained by running the accused apparatus to perforate and make such a test over running a formation tester and a perforating gun separately to make the test, except a saving in time required to perform the operations.

"71. Approximately ninety-eight per cent (98%) of the use of the accused apparatus is devoted to making water shut-off tests in well casing."

* * * * * *

"34. Under normal and usual circumstances as described above in findings Nos. 25-30, the device of the Lane patent in suit, as disclosed therein, would be impractical in industry to recover and bring to the surface of the well a beneficial test sample, without the additional use of other auxiliary equipment or devices and operations not described or illustrated in the patent, and by a mode of operation not described or illustrated in the patent."

* * * * * *

"37. If the Lane device were employed to make a test and separate instrumentalities, such as bailers, were required to remove the test sample from the device so that the sample may be brought to the surface, as much time would be required, under the conditions described above in findings Nos. 25-30, to make the test and recover such sample as would be required by the use of a separate perforating gun and formation tester."

bined perforators and guns. The balance or two per cent (2%) of the field of use is in testing oil producing sands. The Court found as a fact that in such two per cent (2%) of use, the taking of a test immediately following perforation would result in obtaining a formation sample such as could not be obtained where a test is made in a matter of several hours after perforation. (Finding No. 42, R. 61.)

The reason that a different sample is obtained is that where a sample taken after an interval of hours between perforating and testing, there is an increase of one to five per cent in the amount of filtrate water taken into the tester with the sample. *The Court in its Finding of Fact No. 45* (R. 62), *however, finds that normally such an additional amount of filtrate water would not have any disadvantageous effect as far as the efficiency of the test is concerned.* We quote Finding of Fact No. 45:

> "45. When a sample of the native formation fluid is obtained in the tester, an increase of one to five per cent in the amount of filtrate water taken into the tester with said sample would not normally have any disadvantageous effect as far as the efficiency of the test is concerned, in determining the nature and characteristics of the native formation fluid."

Therefore, even in the two per cent (2%) of use outside of the making of water shut-off tests, no improved result other than that of a trivial character is obtained by a combined gun and tester, and even in this use, the patented apparatus accomplishes no time

saving in making the test due to the fact that the sample must be bailed or in some fashion removed from the tester, as in a water test set out above.

Thus, we urge that this total lack of any improvement or advance over the prior art renders the apparatus of the patent in suit unpatentable as totally lacking invention and patentable utility. The Courts have uniformly refused to sustain such patents where the advance forward, if any, was insignificant or trivial.

Seymour v. Ford Motor Co., (C.C.A. 6—Nov. 5, 1930), 44 Fed. (2d) 306:

> "Congress has defined the meaning of the term 'invention' as including 'any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof. * * *' 35 U.S. Code § 31. (35 U.S.C.A. § 31.)
>
> * * * * * * *
>
> The step forward, if any, was insignificant and trivial in the art, and without commercial acceptance or use, except as defendant's device overstepped the line. * * * The change is rather of that trivial and commonplace character which bespeaks an absence of the faculty of invention, as in Maceskid Service Chain Co. v. Perdue, 1 F. (2d) 924 (C.C.A. 6); and the lack of prior uses of patent anticipation is due, we think, to the absence of a real need or problem to be solved. Compare, also, Tolfree v. Wetzler, 22 F. (2d) 214 (D.C.N.J.); Carson Inv. Co. v. Anaconda Copper Mining Co., 17 F. (2d) 815, 824 (D.C. Mont.)."

The Supreme Court (1941) in *Cuno Engineering Corp. v. Automatic Devices Corp.,* 314 U.S. 84, 62 S.Ct. 37, clearly so ruled:

> "To incorporate such a thermostatic control in a so-called 'wireless' or 'cordless' lighter was not to make an 'invention' or 'discovery' within the meaning of the patent laws. * * * More must be done than to utilize the skill of the art in bringing old tools into new combinations. (Citing cases.)
>
> * * * * * * *
>
> * * * Under the statute, 35 U.S.C. § 31, 35 U.S.C.A. § 31, R.S. § 4886, the device must not only be 'new and useful', it must also be an 'invention' or 'discovery'. Thompson v. Boisselier, 114 U.S. 1, 11, 5 S.Ct. 1042, 1047, 29 L.Ed. 76. Since Hotchkiss v. Greenwood, 11 How. 248, 267, 13 L.Ed. 683, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art. (Citing cases.)"

On this same point the Circuit Court of Appeals for the Eight Circuit in *Oro Equipment Corporation v. Herring-Wissler Co.* (1936), 84 Fed. (2d) 619, at 622, held:

> "'Mere novelty and utility is not invention and cannot be substitute thereof.'"

This Court in *Keszthelyi v. Doheny Stone Drill Co. et al.,* 59 Fed. (2d) 3, at 8, said:

> "In the case of Klein v. City of Seattle, 77 F. 200, 204, this court said:

'* * * In the language of the supreme court: "*It is not enough that a thing shall be new,* in the sense that, in the shape or form in which it is produced, it shall not have been before known, and that it shall be useful, but *it must, under the constitution and statute, amount to an invention or discovery.*" Hill v. Wooster, 132 U.S. 693, 701, 10 S.Ct. 228, 231 (33 L.Ed. 502), and authorities there cited.' "

See also:

Sandy MacGregor Co. et al. v. Vaco Grip Co. (C.C.A. 6) (December 11, 1924), 2 Fed. (2d) 655.

Therefore, one must conclude from the Findings of Fact of the District Court that the apparatus illustrated and described in the patent *fails to accomplish a new result, fails to accomplish an improved result, and fails to accomplish an old result in a more economical or facile fashion,* and that for this reason its production did not rise to the dignity of an invention, and it does not have the usefulness required of a patentable invention by the statutes, and the patent is, therefore, totally invalid.

THE CLAIMS OF THE PATENT IN SUIT ARE SO BROAD AND AMBIGUOUS AS TO BAR ANYONE FROM USING (a) A GUN PERFORATOR AND A PACKER CONNECTED TOGETHER (CLAIMS NOS. 7 AND 12 OF LANE PATENT), (b) A GUN PERFORATOR AND A FORMATION TESTER (HAVING THE USUAL PACKER) CONNECTED TOGETHER (LANE CLAIMS NOS. 8, 9, 11, 13 AND 14), REGARDLESS OF THE CONSTRUCTION AND MODE OF OPERATION OF SAID DEVICES, AND ARE THEREFORE TOTALLY INVALID AS BEING FUNCTIONAL, AMBIGUOUS, INDEFINITE AND FAILING TO COMPLY WITH R. S. § 4888.*

For the convenience of the Court, we set out the claims of the Lane patent in suit hereafter and state to the Court that these claims are typical of the remaining claims in the patent not sued upon, and urge that they are totally and completely invalid because they are functional, ambiguous, indefinite and failing to comply with R. S. § 4888.*

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*Addressed to Specification of Errors 11 and 12.

*Revised Statutes § 4888:

"Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. * * *"

(The Claims)	(Our Comments)
Claim No. 7	
In combination	
a packer adapted when set to divide a well casing into upper and lower zones	*packer defined solely by its function*
and a gun means suspended from said packer in said lower zone, said gun means arranged to drive a projectile through the surrounding well casing	*the gun means is not defined by physical or operative characteristics but solely by its function*
Claim No. 8	
In combination	
a packer adapted when set to divide a well casing into upper and lower zones	*packer defined solely by its function*
a gun means suspended from said packer in said lower zone; said gun means arranged to drive a projectile through the surrounding well casing	*the gun means is not defined by physical or operative characteristics but solely by its function*
and a formation testing device for collecting a sample of well fluid admitted into the lower zone through the perforation made by said projectile	*the formation testing device is not defined by its physical or operative characteristics but solely by its function*
Claim No. 9	
A formation tester comprising	
packer means providing a region sealed from the zones above and below said packer means	*packer defined solely by its function*
a gun unit disposed so as to fire a projectile from said region into the surrounding formation	*the gun unit is not defined by physical or operative characteristics but solely by its function*

(The Claims)	(Our Comments)
and a receiving device arranged to receive fluid introduced into said region from the path made by said projectile	*the receiving device is not defined by its physical or operative characteristics but solely by its function*
Claim No. 11 A formation tester comprising	
a gun unit adapted to be lowered into a well bore arranged to fire a projectile through a well casing into a surrounding formation	*the gun unit is not defined by physical or operative characteristics but solely by its function*
a sample receiving means having an inlet in proximity to said gun unit	*the receiving means is not defined by its physical or operative characteristics but solely by its function*
and packer means for minimizing the introduction of fluids into said sample receiving means from sources other than the avenue provided by said projectile	*packer defined solely by its function*
Claim No. 12 In combination	
a packer for dividing a well bore into two zones	*packer defined solely by its function*
and gun means connected with the packer for firing a projectile into the formation surrounding the well bore to open one of said zones to flow of fluids from said formation along the path formed by said projectile	*the gun means is not defined by physical or operative characteristics but solely by its function*
Claim No. 13 A gun type formation tester comprising	

(The Claims)	(Our Comments)
a gun means adapted to be lowered into a well bore and fire a projectile into the adjacent formation to form a fluid channel from the formation into the well bore	*the gun means is not defined by physical or operative characteristics but solely by its function*
and means for entrapping for withdrawal fluid entering the well bore from said channel and having an intake port connectible with said channel	*the "means" is defined solely by its function and not by any physical or operative characteristics*
said gun means and entrapping means forming a tool entity adapted to be lowered as a unit into a well bore	*no relative positioning or manner of forming them into a tool entity is defined*
Claim No. 14	
In combination	
a packer for dividing a well bore into two zones	*packer defined solely by its function*
gun means connected with the packer for firing a projectile into the formation surrounding the well bore to open one of said zones to flow of fluids from said formation along the path formed by said projectile	*the gun means is not defined by physical or operative characteristics but solely by its function*
and means for entrapping for withdrawal fluid entering the perforated zone and having an intake passage connectible with said fluid receiving zone	*said "means" being defined entirely by its function and not by its physical or operative characteristics*
said means adapted to be lowered with said packer and gun means and forming a tool entity therewith	*no physical or structural characteristics or devices or modes of forming the three instruments into a tool entity or their relative positions or the interrelation therebetween is defined*

The Court will note that these claims if construed literally would bar anyone from using in an oil well any device heretofore or hereafter invented which combines any type of gun perforator and any type of packer both old in the art, or which combines any type of well tester, gun perforator or packer.*

Claims of this character have been uniformly held invalid ever since 1853, commencing with the case of *O'Reilly v. Morse,* 15 How. 62, 112 (1853), 14 L.Ed. 601 (the telegraph case), in which our Supreme Court held:

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*Appellee Lane-Wells baldly admits and the District Judge understood that the claims of the patent in suit "cover" any packer and any gun means. At R. 356-357 the following admissions were made:

"The Court: Perhaps we can save time on claim 7, Exhibit 1. Does the defendant claim it means any particular type of packer or does it mean any packer that will serve the purpose—any packer that will function as a packer?

"Mr. Foster: Any packer that will function as a packer for the purposes described in the patent, yes, your Honor.

"The Court: There is no invention claimed in the packer itself?

"Mr. Foster: No, sir.

(Testimony of Frank E. O'Neill.)

"The Court: Doesn't that meet the question?

"Mr. Mellin: That would as to one element.

"The Court: As far as claim 7 is concerned.

"Mr. Mellin: Claim 7 goes on, your Honor:

> 'In combination; a packer adapter when set to divide a well casing into upper and lower zones; and a gun means suspended from said packer in said lower zone; said gun means arranged to drive a projectile through the surrounding well casing.'

"I should like to, and I think I am entitled to ask the witness whether or not that describes, that description of the gun means describes to him any particular gun means or all gun means capable of accomplishing that function.

"The Court: I will sustain the objection upon the ground it is clear to me. It does not describe any particular means. I do not need an expert on that.

"Mr. Mellin: All right, your Honor."

"He (Morse) claims the exclusive right to every improvement where the motive power is the electric or galvanic current, and the result is the marking or printing intelligible characters, signs, or letters at a distance. If this claim can be maintained, it matters not by what process or machinery the result is accomplished. For aught that we know, some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any part of the process or combination set forth in the plaintiff's specification * * *"

See also:

Risdon v. Medart, 158 U.S. 68, 77, 15 S.Ct. 745, 39 L.Ed. 899.

To the same end is the leading case of *General Electric Co. v. Wabash Appliance Corporation et al.,* 304 U.S. 364, 58 S.Ct. 899 (1938), in which the Court held:

"* * * But Congress requires, for the protection of the public, that the inventor set out a definite limitation of his patent; that condition must be satisfied before the monopoly is granted. * * *"

Universal Oil Products Co. v. Globe Oil & Refining Co., 322 U.S. 471, 64 S.Ct. 1111:

"* * * The claim is required to be specific for the very purpose of protecting the public against

extension of the scope of the patent. (Citing cases)."

Boyden Power-Brake Co. et al. v. Westinghouse et al., Westinghouse et al. v. Boyden Power-Brake Co. et al., 170 U.S. 537, 707 (1898):

"The difficulty we have found with this claim is this: That, if it be interpreted simply as a claim for the function of admitting air to the brake cylinder directly from the train pipe, it is open to the objection (held in several cases to be fatal) that the mere function of a machine cannot be patented."

Holland Furniture Co. v. Perkins Glue Co., 277 U.S. 245, 474 (1928).

Otis Elevator Co. v. Pacific Finance Corporation, 71 Fed. (2d) 641 (C.C.A. 9):

"* * * Although it is true, as petitioner suggests, that a function is not patentable because it is not within the patentable subject-matter defined in Rev. St. Sec. 4886 (35 U.S.C.A. Sec. 31), it is also true that a patent claim may be invalid for insufficiency of description under section 4888, because it describes the invention in terms of function or result without sufficient description of the means devised to accomplish that function or result. (Citing cases.)"

Otis Elevator Co. v. Pacific Finance Corporation et al., 68 Fed. (2d) 664 (C.C.A. 9, 1934).

"Even a casual reading of the claim and the master's finding discloses that the invalidity was not merely because of indefiniteness, but because it covered only a function."

B. B. Chemical Co. v. Cataract Chemical Co., 112 Fed. (2d) 526 (C.C.A. 2, 1941).

United Carbon Co. et al. v. Binney & Smith Co., 317 U.S. 228, 63 S.Ct. 165.

American Lava Co. et al. v. Steward et al., 155 Fed. 731 (C.C.A. 6, 1907);
Kalle & Co. et al. v. Multazo Co., Inc., 109 Fed. (2d) 321 (C.C.A. 6, 1940).

Following all these cases is the case of

Halliburton Oil Well Cementing Company v. Walker et al., 71 U.S.P.Q. 175 (decided Nov. 18, 1946), Sup. Ct.

"Under these circumstances the broadness, ambiguity, and overhanging threat of the functional claim of Walker become apparent. What he claimed in the court below and what he claims

here is that his patent bars anyone from using in an oil well any device heretofore or hereafter invented which combined with the Lehr and Wyatt machine performs the function of clearly and distinctly catching and recording echoes from tubing joints with regularity. Just how many different devices there are of various kinds and characters which would serve to emphasize these echoes, we do not know. The Halliburton device, alleged to infringe, employs an electric filter for this purpose. In this age of technological development there may be many other devices beyond our present information or indeed our imagination which will perform that function and yet fit these claims. And unless frightened from the course of experimentation by broad functional claims like these, inventive genius may evolve many more devices to accomplish the same purpose. See United Carbon Co. et al. v. Binney & Smith Co., 317 U.S. 228, 236 (55 U.S.P.Q. 381, 385-386); Burr v. Duryee, 1 Wall. 531, 568; O'Reilly, et al. v. Morse, et al., 15 How. 62, 112-13. *Yet if Walker's blanket claims be valid, no device to clarify echo waves, now known or hereafter invented, whether the device be an actual equivalent of Walker's ingredient or not, could be used in a combination such as this, during the life of Walker's patent.*

Had Walker accurately described the machine he claims to have invented, he would have had no such broad rights to bar the use of all devices now or hereafter known which could accent waves. For had he accurately described the resonator together with the Lehr and Wyatt apparatus, and sued for infringement, charging the use of something else used in combination to ac-

cent the waves, the alleged infringer could have prevailed if the substituted device (1) performed a substantially different function; (2) was not known at the date of Walker's patent as a proper substitute for the resonator; or (3) had been actually invented after the date of the patent. Fuller v. Yentzler, supra, at 296-97; Gill v. Wells, supra, at 29. Certainly, if we are to be consistent with Rev. Stat. 4888, a patentee cannot obtain greater coverage by failing to describe his invention than by describing it as the statute commands."

This Court of Appeals in *Farmer's Cooperative Exchange, Inc. v. Turnbow et al.,* 111 Fed. (2d) 728, followed the rule. In that case the Court said:

"Claim 8, of the claims in question, is one of the most specific. It is: 'A non-lethal parasiticide for internal administration, for intestinal parasites, comprising the combination of a nicotine substance in a dose normally parasiticidal to said parasites and lethal to the subject being treated on ingesting the same alone, and an organic colloid, said organic colloid rendering said dose non-lethal to the subject being treated and leaving it parasiticidal to said parasites.'

* * * * * * *

* * * As said in General Electric Co. v. Wabash Appliance Corp., 304 U. S. 364, 368, 58 S. Ct. 899, 901, 82 L. Ed. 1402: '* * * Recognizing that most inventions represent improvements on some existing article, process, or machine, and that a description of the invention must in large part set out what is old in order to facilitate the understanding of what is new, Congress requires

of the applicant "a distinct and specific statement of what he claims to be new, and to be his invention." (35 U.S.C.A. § 33.) Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirement as to claims of invention or discovery. * * *'

The claims here violate that rule, and are void because 'conveniently functional language at the exact point of novelty' is used. General Electric Co. v. Wabash Appliance Corp., supra, 304 U.S. 371, 58 S. Ct. 903, 82 L. Ed. 1402. See, also Wood v. Underhill et al., 46 U. S. 1, 4, 5 How. 1, 4, 12 L. Ed. 23; The Incandescent Lamp Patent, 159 U. S. 465, 474, 16 S. Ct. 75, 40 L. Ed. 221.

In this connection appellees in attempting to distinguish General Electric Co. v. Wabash Appliance Corp., supra, contend that 'each and every of these claims specify the ingredients as well as the quantity or proportion of such ingredients'. We are unable to agree with that contention. *An entire class of ingredients is specified not specific 'ingredients'.* The quantity or proportion of the class is not specified except 'in conveniently functional language'.

The instant case is one illustrative of the practice followed in many patents. The inventors experimented with and compounded particular alkaloidal substances with particular colloidal substances. Instead of confining their claims to that which they actually discovered, if anything, they attempted to monopolize all parasiticides which could be made from the entire class of alkalodial substances with the entire class of colloidal substances."

In applying the above case and the *Halliburton* case, the Lane patent claims specify only,

(a) the entire class of formation testers
(b) the entire class of gun perforators
(c) the entire class of packers

without regard to the construction or mode of operation of such devices and, therefore, are invalid.

A further case in point is *Heidbrink et al. v. McKesson,* 290 Fed. 665 (C.C.A. 6, 1923). One claim in controversy was as follows:

> "2. A gas-administering device having a mixing chamber, means for supplying thereto from independent sources of supply a plurality of gases each under pressure and in fixed proportions at their respective pressures, means for controlling the respective pressures at which the several gases are delivered to the mixing chamber, and means for definitely regulating and determining the aggregate volume of flow of said gases into the mixing chamber at their respective pressures while maintaining said fixed proportions.
> * * * * * * *
>
> With this statement of the situation, we come to his two claims of 1,265,910. We are compelled to think that they are invalid because functional. They are apparently most deliberately and skillfully drafted to cover any means which any one ever may discover of producing the result; that is, to accomplish the one thing while avoiding the other. We think they are clearly to be condemned under the rule stated in O'Reilly v. Morse, 15 How. 62, 112, 14 L. Ed. 601, Risdon v. Medart, 158 U. S. 68, 77, 15 Sup. Ct. 745, 39 L.

Ed. 899, and the many familiar cases applying the rule, and that they are not within the principle of the Telephone Case, 126 U. S. 1, 634, 8 Sup. Ct. 778, 31 L. Ed. 863."

We urge, therefore, that this Court find the patent claims of the patent in suit totally invalid on the grounds that they are functional, ambiguous, indefinite and failing to comply with R. S. § 4888.

THE RULE OF THE HALLIBURTON CASE AS APPLIED BY THE VARIOUS CIRCUIT COURTS OF APPEALS SHOWS ITS PERTINENT APPLICABILITY TO THE SUIT AT BAR.

Refrigeration Patents Corporation v. Stewart-Warner Corporation (C.C.A. 7), 159 Fed. (2d) 972, at 976.

"As an answer to this contention, the Halliburton case, supra, states: *'Patents on machines which join old and well-known devices with the declared object of achieving new results, or patents which add an old element to improve a pre-existing combination, easily lend themselves to abuse. And to prevent extension of a patent's scope beyond what was actually invented, courts have viewed claims to combinations and improvements or additions to them with very close scrutiny. * * * It is quite consistent with this strict interpretation of patents for machines which combine old elements to require clear description in combination claims. * * ** Cogent

reasons would have to be presented to persuade us to depart from this established doctrine.'

Appellees say that 'neither defendant, nor anyone else, need have any difficulty in determining whether its coil is so constructed and operated as to be non-frosting * * *.' Since a 'non-frosting coil' is a desired *result,* and not a means, it seems evident to us that patentees should be entitled at most only to their particular inventive means to achieve that result, not every possible means which may be conceived in the future to achieve the same result. As the Supreme Court said in the Halliburton case, supra: 'In this age of technological development there may be many other devices beyond our present information or indeed our imagination which will perform that function and yet fit these claims. And unless frightened from the course of experimentation by broad functional claims like these, inventive genius may evolve many more devices to accomplish the same purpose. * * *.' ''

CONCLUSION.

We respectfully submit that this Court should find the patent in suit and the claims thereof totally invalid upon each of the following grounds:

(a) That the patent does not disclose a patentable invention.

(b) That the patent in suit purports to cover a mere aggregation and not a patentable combination.

(c) That the patent in suit does not describe and illustrate an apparatus which will work practically in industry, and the patent is therefore invalid under R. S. § 4888.

(d) That the apparatus disclosed in the patent in suit will not work practically in industry when constructed and operated in accordance with the specifications and drawings of the patent and the patent is therefore invalid.

(e) That the claims of the patent in suit are so functional, ambiguous and indefinite that they fail to comply with R. S. § 4888 and are therefore invalid.

We further respectfully submit that the District Court's ultimate findings and conclusions that the apparatus of the patent in suit involved invention, and that said patent and its claims are valid, are in error and that that portion of the judgment of the District Court adjudging said patent and the claims thereof to be valid should be reversed.

Dated, San Francisco, California,
March 4, 1949.

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